

REMARKS

In the Official Action, claims 1, 4, and 7 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 4,408,928 to Steinke. Claims 2, 5, and 6 were rejected under 35 U.S.C. § 103(a) as unpatentable over Steinke in view of U.S. Patent No. 5,259,165 to Koyama. Claim 3 was rejected under 35 U.S.C. § 103(a) as unpatentable over Steinke.

As amended, claim 1 includes the additional limitation that the stud extends beyond the second hole to suspend attachment hardware therefrom and secure the anchor plate and engagement plate to the steel web joist. This additional limitation is supported by Figure 1 of the specification and the accompanying description.

In order for Steinke to anticipate claim 1, all claimed limitations in amended claim 1 must be disclosed in the reference. See MPEP § 2131. Steinke does not disclose all the limitations of amended claim 1. Figs. 1 – 5 of Steinke and the accompanying description disclose an anchor plate (41) with a first hole (45) extending across a slot (35) in a beam (30). The beam includes two first legs (34) forming a plane across which the anchor plate extends, and two second legs (36) extending into the interior of the beam. An engagement plate (50) having a flat anchor portion (51) having a second hole (53) and upstanding engagement portions (52) to either side is inserted into the beam. Each engagement portion has a distal edge having an engagement profile for interlocking with the first legs. A stud (58) extends from the anchoring plate, through the slot in the beam, and to the engagement plate. The anchoring plate and the engagement plate are secured to the beam using the stud. Steinke, however, does not

disclose that the stud extends beyond the engagement plate so that attachment hardware may be suspended from the stud. To the extent that the stud disclosed in Steinke extends beyond the engagement plate, it is to secure the engagement plate and the anchoring plate to the beam. See Col. 4, l. 60 – Col. 5, l. 10. Amended claim 1 is thus not anticipated by Steinke, and allowance of amended claim 1 is requested.

Claim 4 is dependent upon claim 1 and was also rejected as anticipated by Steinke. For the same reasons that Steinke does not anticipate amended claim 1, neither does it anticipate claim 4. Allowance of claim 4 is therefore requested.

Claim 7 was rejected as anticipated by Steinke. Claim 7 as amended also includes the additional limitation that the stud extends beyond the second hole to suspend attachment hardware therefrom. As discussed in relation to claim 1 above, Steinke does not disclose this additional limitation. Allowance of claim 7 is therefore requested.

Claims 2, 5, and 6 were rejected as obvious over Steinke in view of Kyoama.

MPEP § 2143 sets the following standard for a finding of obviousness:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

As detailed above, the Steinke reference does not teach or suggest the claim limitation that the stud extends beyond the engagement plate to suspend attachment hardware therefrom. Koyama also does not disclose this limitation.

Both claims 2 and 5 are dependent upon amended claim 1. Claims 2 and 5 are not rendered obvious by the combination of Steinke in view of Koyama because the combination does not teach or suggest all the claimed limitations of amended claim 1. Allowance of claims 2 and 5 is therefore requested.

Claim 6 as amended also includes the additional limitation that the stud extends beyond the second hole to suspend attachment hardware therefrom. As discussed above in relation to claim 1, Steinke in view of Koyama does not teach or suggest this additional limitation. Allowance of claim 6 is therefore requested.

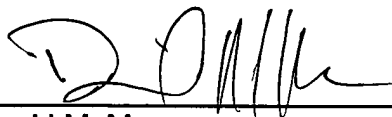
Claim 3 was rejected as obvious over Steinke in view of the knowledge of one skilled in the art. Claim 3 is dependent upon amended claim 1. For the reasons discussed above, Steinke does not teach all the claimed limitations of claim 3. Allowance of claim 3 is therefore requested.

Respectfully submitted,

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MARKED UP VERSION OF CLAIMS TO SHOW CHANGES MADE

1. (amended) A seismic adapter for suspending attachment [to] hardware from a steel web joist including a beam with two angle elements each with a first leg and a second leg, the first legs being parallel with a cord space therebetween and the second legs extending in opposite directions, comprising

an anchor plate having a first hole therethrough and extendable across the cord space into juxtaposition with the second legs;

an engagement plate including a flat anchor portion having a second hole therethrough and upstanding engagement portions to either side of the flat anchor portion, each upstanding engagement portion having a distal edge with an engagement profile for interlocking engagement with the first legs;

a stud extendable from the first hole to and beyond the second hole, with the anchor plate and the engagement plate positioned on the beam of the steel web joist, to suspend the attachment hardware therefrom and secure the anchor plate and the engagement plate to the steel web joist.

6. (amended) A seismic adapter for suspending attachment [to] hardware from a steel web joist including a beam with two angle elements each with a first leg and a second leg, the first legs being parallel with a cord space therebetween and the second legs extending in opposite directions, comprising

an anchor plate having a first, threaded hole therethrough and extendable across the cord space into juxtaposition with the second legs;

an engagement plate including a flat anchor portion having a second hole therethrough and upstanding engagement portions to either side of the flat anchor portion, each upstanding engagement portion having a distal edge for interlocking engagement with the first legs and being at an obtuse angle to the flat anchor portion, the distal edge forming a tongue extendable to between the first legs of the steel web joist in the cord space and shoulders to either side of the tongue to abut against the first legs, the tongue being tapered inwardly toward the distal extent thereof;

a threaded stud extendable from the first, threaded hole to and beyond the second hole, with the anchor plate and the engagement plate positioned on a steel web joist, to suspend the attachment hardware therefrom and secure the anchor plate and the engagement plate to the steel web joist.

7. (amended) A seismic adapter for suspending attachment [to] hardware from a steel web joist including a beam with two angle elements each with a first leg and a second leg, the first legs being parallel with a cord space therebetween and the second legs extending in opposite directions, comprising

a plate means for anchoring across the cord space into juxtaposition with the second legs;

an engagement plate including a flat anchor portion having a hole therethrough and engagement means for interlocking engagement with the first legs to either side of the flat anchor portion;

a stud extendable from the plate means to and beyond the hole, with the anchor plate and the engagement plate positioned on the beam of the steel web joist, to

suspend the attachment hardware therefrom and secure the anchor plate and the engagement plate to the steel web joist.